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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,119	08/21/2001	Makoto Inoue	LIN.001	4969

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EXAMINER

O'CONNOR, GERALD J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/933,119

Applicant(s)

Inoue et al.

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on October 15, 2004 (Response to Req't for Restriction).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 9-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on November 30, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restriction

1. Applicant's election without traverse of the invention of Group I, claims 1-8, in the reply filed October 15, 2004 is hereby acknowledged.

2. Claims 9-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed October 15, 2004.

Claim Objections

3. Claims 1-8 are objected to because of the following informalities: the claims appear to be a literal translation into English from a foreign document, failing to conform with current U.S. practice for being replete with grammatical and idiomatic errors.

Additionally, exemplary language, such as the phrase "such as" in claims 4 and 6, is inappropriate language for use in a claim because it is unclear whether or not the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e)¹ the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1 and 3-8 are rejected under 35 U.S.C. 102(b) as being anticipated by King et al. (US 5,319,542).

King et al. disclose a system for ordering items comprising a database having a various kinds of masters, and a server which controls data communication with a plurality of terminals via a network and performs extracting or storing to the various kinds of masters in response to the terminal, wherein the database comprising: a merchandise master which stores information

¹ The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) apply to the examination of this application as the application being examined was (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) as amended by the AIPA (post-AIPA 35 U.S.C. 102(e)).

on items offered from dealers to customers by each item number unique to the item, and a merchandise assortment (MD) related master which stores a list of traded items among the items stored in the merchandise master agreed upon between the customer and dealer beforehand as the customer specific MD related information by each purchasing unit of the customer and by each dealer who offers the item to the customer, wherein the server comprising an item specific order controller for specifying, for each item, a dealer who offers each item in the ordering request, based on the MD related information of each purchasing unit, when it receive an ordering request for ordering one or more items from the terminal used by a user who belongs to the purchasing unit.

Regarding claims 3 and 7, the recited use/application has been deemed merely intended usage of the invention, hence, afforded little patentable weight. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See MPEP §2114.

Regarding claim 4, with the system of King et al., if the item number to be purchased by the customer is duplicated by a plurality of dealers, the MD related master has a dealer decision items such as delivery time, price, or dealer priority rank for specifying a dealer according to the item number, wherein the item specific ordering controller comprising a dealer duplication time specification function, and if the item number of an item requested for ordering is duplicated by

dealers when the order request is received by the user who belongs to the purchasing unit, the function specifies a dealer for the item according to the dealer decision item of the item number.

Regarding claim 5, the item specific ordering controller of King et al. comprises an approval standard specific ordering control function for the case where the approval standard on ordering items is determined by the customer, when one or more items are selected by a user of the customer, and if the approval standards of the selected items and the items to be added newly are different, the function prompting ordering grouped by the same approval standard without accepting the addition of new items.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over King et al. (US 5,319,542).

King et al. disclose a system for ordering items, as applied above in the rejection of claim 1 under 35 U.S.C. 102(b), but the system of King et al. does not explicitly address delivery of the items being ordered. However, arranging for delivery of items being ordered by selecting

a deliverer (e.g., UPS, FedEx, etc.) to deliver the items, either separately or in any convenient combination of items, is a well known, hence obvious, function to perform when placing an order for items. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to modify the system of King et al. so as to include a deliverer specific controller for specifying a deliverer who, when the ordering request is received from the terminal used by a user in the purchasing unit, delivers an item to the user separately for each item number based on the MS related information for each of the purchasing unit, and a dealer data outputting controller for outputting, to the terminal used by the deliverer, the dealer data used for delivering the item from the deliverer specified for the item to the user in the name of the dealer specified for each item, in order to receive the items being ordered at an optimum balance of cost and leadtime, as determined by the customer paying the bill, since so doing could be performed by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to the disclosure.
9. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(703) 305-1525**, and whose facsimile number is **(703) 746-3976**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

Inquiries of a general nature or simply relating to the status of the application should be directed to the receptionist, whose telephone number is (703) 308-1113.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at (703) 308-5183.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (fax-back auto-reply receipt service provided). Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be left with the receptionist on the seventh floor of Crystal Park Five, 2451 Crystal Dr, Arlington, VA 22202.

GJOC

January 21, 2005



Gerald J. O'Connor
Patent Examiner
Group Art Unit 3627